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EXAMINER

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID S. MAJKRZAK

Appeal 2009-009943
Application 10/772,122
Technology Center 3600

Before WILLIAM F. PATE, III, JOHN C. KERINS, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* O'Neill.

Opinion Concurring filed by *Administrative Patent Judge* Kerins.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown in the PTOL-90A cover letter attached to this decision.

David S. Majkrzak (Appellant) seeks our review under 35 U.S.C. § 134 of the rejection of claims 1, 2, 4, 5, and 16. Appellant cancelled claims 3 and 6-15. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The claimed invention is to a knife section used on a sickle cutter bar for a harvester.

Claims 1 and 16 reproduced below, with emphasis added, are representative of the subject matter on appeal.

1. A knife section for mounting on a reciprocating sickle bar for a harvester and reciprocating during use across an edge of a stationary sickle guard, said knife section being flat and having a top surface plane and comprising a base with a laterally extending base edge, the knife section having a leading end spaced from the base edge, mounting holes in the base for securing the knife section to a sickle bar, the knife section having a central dividing plane perpendicular to the top surface plane of the knife section and bisecting the top surface plane between the base and leading end, and the base having side edges parallel to the central dividing plane, the side edges of the base having a length of between 40% and 50% of a distance from the base edge to the leading end, the leading end being of substantially less lateral width perpendicularly to the center dividing plane than a width between the side edges of the base, as defined by the base edge, a pair of cutting edges, one on each side of the knife section and each cutting edge defining a cutting line that continually moves away from the center plane of the knife section from a first end of such cutting line adjacent the leading end to a second end of the cutting line at a junction of the cutting line with a respective side edge on the respective side of the base of the knife section, and *each cutting line being concave with respect to a straight line between the first and second ends of the respective cutting line being about 14% of the length of the straight line,*

such that the opening between adjacent knife sections placed edge to edge on a sickle bar results in increased feed area for crop material that is cut with each reciprocation of the knife section when installed on a sickle bar.

16. A knife section for mounting on a reciprocating sickle bar for a harvester and reciprocating during use across an edge of a stationary sickle guard, the knife section comprising:

- a substantially flat top surface;
- a substantially flat bottom surface being substantially parallel to the substantially flat top surface;
- a base edge;
- a leading end opposite the base edge;
- a left side edge extending from the base edge about one half of a distance between the base edge and the leading end;
- a right side edge extending from an opposite side of the base edge about one half of the distance between the base edge and the leading end;
- an arcuate left cutting edge extending between the left side edge and the leading end, wherein the left cutting edge comprises a left serrated cutting edge; and
- an arcuate right cutting edge extending between the right edge and the leading end, wherein the right cutting edge comprises a right serrated cutting edge and wherein a distance between the left cutting edge and the right cutting edge continually increases from the leading end to the left and right side edges, *wherein the arcuate cutting edges are of a configuration that defines a portion of a substantially elliptical cutting edge when a left side edge of one knife section is positioned substantially adjacent to a right side edge of another knife section.*

The Rejections

The following Examiner's rejections are before us for review:

Claims 1, 2, 4, and 5 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claim 16 under 35 U.S.C. § 103(a) as unpatentable over Poget (French Patent Application Publication No. FR 2 595 190, published Sep. 11, 1987) and Isbell (U.S. Patent No. 4,380,889, issued Apr. 26, 1983).

SUMMARY OF DECISION

We AFFIRM.

OPINION

Issues

In light of the Appellant's contentions and the Examiner's positions, the issues before us are as follows:

(1) Did the Examiner err in determining that the claim limitation of "each cutting line being concave with respect to a straight line between the first and second ends of the respective cutting line being about 14% of the length of the straight line" (App. Br. 13), added to claim 1 by an amendment filed February 6, 2006, constitutes new matter and thus rejected the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement for not being supported by the original disclosure? Ans. 3.

(2) Did the Examiner err in interpreting Poget to disclose that "the arcuate cutting edges are of a configuration that defines a portion of a substantially elliptical cutting edge when a left side edge of one knife section is positioned substantially adjacent to a right side edge of another knife section" (App. Br. 15)? Ans. 4-5.

Analysis

Issue 1

Appellant contends that the Examiner erred in rejecting claims 1, 2, 4, and 5 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement because claim 1's recitation of "about 14%" is not new matter since it is present in the Figures as originally filed. App. Br. 10. More particularly, Appellant contends that Figures 1-5 support claim 1's recitation of "about 14%" to show that Appellant did have possession of the subject matter illustrated in the drawings as of the filing date. App. Br. 11. Indeed, Appellant contends that "[t]he drawings show the 'about 14%' relationship that was disclosed in the application filed as [Appellant] did not alter the curve in the drawings with the Amendment of February 6, 2006." *Id.* Appellant also contends that the Amendment filed February 6, 2006 merely "provided a description of the shape of the curved surface by drawing a line between the ends of the curve and drawing a perpendicular line between the curve and the line" and that "[t]his ratio is another description of a curved surface that was graphically depicted in the Figures as filed." *Id.* In other words, Appellant contends that the term "about 14%" was disclosed in the original disclosure and is not new matter because Appellant graphically depicted the cutting edge at the time the application was filed to have possession of the invention. *Id.* Appellant also contends that the Examiner's reliance on *Hockerson-Halberstadt, Inc. v. Avia Group Int'l.*, 222 F.3d 951, 956 (Fed. Cir. 2000) is misplaced since that "case stands for the proposition of what is prior art and what is disclaimed matter" and "did not mention whether or not an amendment made to a claim was new matter or not." *Id.* Appellant also contends that "the Office Action is

confusing the issue of what is new matter with the issue of what a drawing discloses as prior art.” *Id.* Appellant also contends that “the fact that [Appellant] did not state that the Figures were drawn to scale is not determinative whether or not the ‘about 14%’ is new matter because [Appellant,] in order to satisfy the best mode requirement[,], had to provide the drawings with a cutting edge having the claimed curved cutting edge.” App. Br. 12. Appellant also contends that the Examiner erred in stating that Appellant cannot rely on the drawings being to scale without so stating because *Hockerson-Halberstadt* requires stating that the drawings are to scale for scope of the prior art purposes, but that it is not necessary to state the drawings are to scale for new matter purposes because it is clear that the drawings and its dimensions are disclosed at the time of filing. Reply Br. 5-6.

The Examiner’s position is that claims 1, 2, 4, and 5 do not comply with the written description requirement of 35 U.S.C. § 112, first paragraph, because those claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Ans. 3. More particularly, the Examiner posits that claim 1’s recitation of “each cutting line being concave with respect to a straight line between the first and second ends of the respective cutting line being about 14% of the length of the straight line” (App. Br. 13) was not a part of the original specification and claims and was added by amendment on February 6, 2006, to thus constitute new matter. Ans. 3. The Examiner cites *Hockerson-Halberstadt*, which in turn cites to *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977), for the proposition that

“patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Id.* The Examiner posits that “in this instant case, [Appellant] was silent on the issue of dimensions of the drawings and therefore[,] any arguments based on measurement of the drawing features are of little value” and cites to the Manual of Patent Examining Procedure (MPEP) § 2125. *Id.*

Compliance with the written description requirement set forth in the first paragraph of 35 U.S.C. § 112 does not require that the claimed subject matter be described identically, but the disclosure as originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed. *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). Stated using somewhat different terminology, the applicant must convey, with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, (Fed. Cir. 1991). Precisely how close the original description must come to comply with the description requirement must be determined on a case by case basis. *In re Smith*, 458 F.2d 1389, 1395 (CCPA 1972). The inquiry into whether the description requirement is met is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, (CCPA 1976); *In re Ruschig*, 379 F.2d 990, 996 (CCPA 1967).

We agree with the Examiner that the original disclosure fails to support the claim recitation of “about 14%.” The claim recitation of “about 14%” is very specific. We are not persuaded by Appellant’s arguments that the originally filed drawings would have conveyed the very specific “about 14%” to a person of ordinary skill in the art. We are also not persuaded by

Appellant's argument that the Examiner erred in applying *Hockerson-Halberstadt* because MPEP § 2125 lists *Hockerson-Halberstadt* as being a case supporting "Drawings as Prior Art." The MPEP is only guidance. It is not substantive law, and the inclusion of a discussion of the case in a section specific to prior art does not restrict the applicability of the holding of the case. To us, the issue is whether the original disclosure, particularly, the originally filed drawings, would have conveyed the very specific cutting line of "about 14%" to a person of ordinary skill in the art, and we agree with the Examiner that the originally filed drawings do not convey to a person of ordinary skill in the art the very specific cutting line of "about 14%."

In view of the foregoing, we sustain the Examiner's rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 112 first paragraph, as failing to comply with the description requirement.

Issue 2

Appellant contends that the Examiner erred in rejecting claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Poget and Isbell, because when the sickle sections of Poget are aligned adjacent to each other, the cutting edges define a substantially V-shaped cutting edge as shown in Exhibit B attached to the Appeal Brief filed July 30, 2008, not "a substantially elliptical cutting edge" (App. Br. 15) as shown in Appellant's Exhibit A attached to the Appeal Brief filed July 30, 2008. App. Br. 9. Appellant also contends that "there is no suggestion in the Poget patent of increasing the arc of the cutting edge to make the cutting edge substantially elliptical when two sickle sections are positioned adjacent each other" and thus, Poget in view of Isbell does not obviate claim 16. App. Br. 10.

The Examiner's position is that Poget discloses a knife section with substantially all of the structure recited in claim 16, except that Poget fails to explicitly disclose that the left and right cutting edges are left and right serrated cutting edges. Ans. 4-5. The Examiner posits that Isbell discloses a similar knife section with serrated cutting edges to produce highly effective scissors or shearing action. Ans. 5. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify the knife sections of Poget by making the cutting edges be serrated as taught by Isbell "in order to produce an efficient scissor action." *Id.* Responding to Appellant, the Examiner maintains that since Poget's cutting edges are similar in shape to and read on claim 16's limitation of "wherein a distance between the left cutting edge and the right cutting edge continually increases from the leading end to the left and right side edges," there are no differences between Poget's cutting edge and the substantially V-shaped cutting edge of the invention. Ans. 6. The Examiner further posits that "there is no novelty seen either by the examiner or pointed out by the Appellant, nor is it clear that the invention would solve any stated problem or serve any purpose that the sickle of Poget and Isbell could not." *Id.*

We agree with the Examiner that when Poget's knife sections are placed adjacent each other, they define a substantially elliptical cutting edge and not just a V-shaped cutting edge as suggested by Appellant. Indeed, although Poget's knife section has a cutting edge that is less curved or arcuate than the cutting edge of the present invention, this does not mean that Poget's knife section fails to meet the substantially elliptical cutting edge claim language. Moreover, in *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1310-1311 (Fed. Cir. 2003), it was held that "the

phrase ‘generally parallel’ envisions some amount of deviation from exactly parallel,” and that “words of approximation, such as ‘generally’ and ‘substantially,’ are descriptive terms ‘commonly used in patent claims ‘to avoid a strict numerical boundary to the specified parameter.’” In support of this holding, it was noted that “nothing in the prosecution history [of the Anchor Wall patent] . . . clearly limit[ed] the scope of ‘generally parallel’ such that the adverb ‘generally’ does not broaden the meaning of parallel.” *Id.* Similarly, in this case we find that in claiming “a substantially elliptical cutting edge,” Appellant claimed more than an elliptical cutting edge because the word “substantially” is often used to mean largely but not wholly what is specified. *See, e.g., York Products, Inc., v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1572-73 (Fed. Cir. 1996); *See also, Amhil Enterprises Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562, (Fed. Cir. 1996).

Secondary Considerations

Whenever obviousness is found with respect to the subject matter on appeal, and Appellant furnishes evidence of secondary considerations, it is our duty to reconsider the issue of obviousness anew, carefully weighing the evidence for obviousness with respect to the evidence against obviousness. *See, for example, In re Eli Lilly & Co.*, 902 F.2d, 943, 945 (Fed. Cir. 1990).

To be given substantial weight in the determination of obviousness or non-obviousness, evidence of secondary considerations must be relevant to the subject matter as claimed. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 306 n.42 (Fed. Cir. 1985). In particular, an Appellant asserting secondary considerations to support Appellant’s contention of non-obviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of secondary

considerations. For example, in the case of evidence of commercial success, the Federal Circuit has acknowledged that the Appellant bears the burden of establishing a nexus, stating:

In the *ex parte* process of examining a patent application... the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitutes commercial success. *Cf. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40 (Fed. Cir. 1996). *See also In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) and *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the obviousness rejection was not probative of non-obviousness).

Here, the declaration and supporting exhibits fail to establish a nexus between the claimed invention and the evidence of secondary considerations. Insufficient evidence has been provided to support the statements of the declarant in paragraphs 3, 4, 6-12, and 16. Statements without supporting evidence are of little weight to demonstrate non-obviousness. The statements are not tied to any claimed features but rather appear to be tied to the disclosed invention. Further, the statements of purchasers and users of the “Crary King Kut” system are hearsay and appear to be directed to a commercial embodiment and not directed to the claimed

invention. Evidence of non-obviousness must be commensurate in scope with the claims. *See In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971).

After reviewing all of the evidence before us, including the totality of Appellant's evidence, it is our conclusion that, on balance, the evidence of nonobviousness fails to outweigh the evidence of obviousness discussed above and, accordingly, the subject matter of claim 16 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a) at the time Appellant's invention was made.

CONCLUSIONS

The Examiner did not err in determining that the claim limitation of "each cutting line being concave with respect to a straight line between the first and second ends of the respective cutting line being about 14% of the length of the straight line" added to claim 1 by an amendment filed February 6, 2006, constitutes new matter and thus rejected the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement for not being supported by the original disclosure.

The Examiner did not err in interpreting Poget to disclose that "the arcuate cutting edges are of a configuration that defines a portion of a substantially elliptical cutting edge when a left side edge of one knife section is positioned substantially adjacent to a right side edge of another knife section."

DECISION

We affirm the Examiner's rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written

description requirement, and the Examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over Poget and Isbell.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

KERINS, *Administrative Patent Judge*, concurring:

I concur with my colleagues' decision to affirm the Examiner's rejections under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement thereof, and the rejection under 35 U.S.C. § 103(a). I disagree with my colleagues' characterization of the declaratory evidence of secondary considerations and provide below my analysis of that evidence.

The majority summarily dispenses with the evidence set forth in paragraphs 3, 4 and 6-16 of the Declaration of David Majkrzak under 37 C.F.R. § 1.132 ("Declaration"), stating that no evidence has been provided which supports the statements there made, and opining that, "[s]tatements without supporting evidence are of little weight to demonstrate non-obviousness." The majority thus appears to take the position that, in effect, statements made in a verified statement do not constitute evidence unless further supported by documentary or some other form of evidence. I do not subscribe to such a position. Factual statements in a declaration/verified statement are evidence in and of themselves.

The evidence in the form of the Declaration of Mr. Majkrzak has very little probative value for a more specific reason, namely, the evidence does not appear to establish any secondary factor recognized as weighing in favor of non-obviousness. The statements in paragraphs 3, 4, 5, and 12 appear to be attempting to establish that the claimed invention is an improvement over some unidentified prior art device in providing increased cutting capacity, which in turn allows faster operation, while at the same time providing improved structural integrity. The Declaration stops well short of even asserting that *unexpected or surprising* results were obtained; that there was some long felt need, unsolved by others, solved by the claimed invention; or that any degree of significant commercial success has been achieved by the claimed design. Moreover, the allegations of increased capacity, faster operation, and improved structural integrity are seen as being less factual and more conclusory in the absence of any data or test results comparing the claimed device to a device determined to represent the closest prior art. *In re Merchant*, 575 F.2d. 865, 869 (CCPA 1978).

I do agree with my colleagues that the statements made in Exhibits A, B, and C to the Declaration constitute hearsay evidence which is to be afforded little to no weight. The facts set forth in paragraphs 6-11 of the Declaration, while apparently providing the impetus to develop the claimed invention, are of no moment in assessing the patentability thereof.

Thus, a weighing of the evidence favoring non-obviousness together with the evidence of obviousness leads me to conclude, as did my colleagues, that claim 16 is unpatentable over Pogett and Isbell.

I will also take this opportunity to note that I, like the majority, disagree with Appellant's argument that the *Hockerson-Halberstadt* holding,

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that reliance on drawings for specific proportions may not be had where there is no evidence that the drawing are to scale, is applicable only to prior art drawings. The *Hockerson-Halberstadt* decision refused to permit a patentee to rely on *its own drawings* as showing a particular proportion or relationship between two features, in arguing for a particular claim construction. *Hockerson-Halberstadt*, 222 F.3d at 956. Prior art drawings were not specifically at issue in the case.

JCK

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